

MEMORANDUM FOR THE RECORD

SUBJECT: Patent Matters Arising under Procurement Contracts

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1. On 10 April 1956 [] and the undersigned of OGC met with [] of OL for the purpose of advising them of the action taken to date with respect to their previous request for our assistance on patent matters. The several items discussed were (a) the necessity of the Agency's being designated as a "defense agency" for secrecy order purposes, (b) development of procedures for checking Government interest in current patents, and (c) the necessity of employing private patent counsel on a consulting basis.

2. Under the provisions of the Invention Secrecy Act of 1951 (35 USCA 181-188) the Commissioner of Patents may order that an invention be kept secret when notified by a defense agency that publication by granting a patent would be detrimental to national security. "Defense agency" is described as the AEC, Defense or such other agencies as may be designated by the President. To date only the Department of Justice has been so designated (E.O. 10457, dated May 27, 1953). It was pointed out that while the Patent Office (Asst. Comr. Crocker) had indicated that it might be possible for the Agency to come under the Act by having its applications sponsored by a defense agency, subsequent conversations with Defense (Office of Naval Research) and Justice had revealed that they would be unwilling to undertake such a task on a continuing basis; and that under the circumstances a determination must be made as to whether CIA should seek to be designated. OL agreed to contact TSS and the Office of Communications for the purpose of obtaining some estimate of the use to which the Agency would put this new authority if it were granted.

3. The Office of Logistics was briefed on the visit which the undersigned had made to the Patent Office's Assignment and License Branch. The purpose of this call had been to determine what procedures should be established to ensure against paying royalties on patents in which the Government may already have a royalty-free interest. It was learned that pursuant to the provisions of E.O. 9424 of 18 February 1944 the Patent Office maintains a register for the recording of all rights and interests

which the Government may have in patents and that subject to certain conditions these may be inspected by Government personnel. The Office of Logistics was advised that the undersigned is presently accumulating certain of the regulations bearing on the examination of licenses preparatory to drafting procedures for OL's use. They agreed to assign one of their members to assist in this task.

4. As regards the justification for employing private patent counsel, OL was not able to give any firm estimate as to the amount of work which it might have for such an individual. It seems that it is primarily interested in having available an individual technically qualified in the patent law field for the purpose of prosecuting patent applications in those instances when the Agency's contractors may decline to do so. It was pointed out that while future study might indicate a need for private counsel, since the cost would be an undertaking by OL, they might want to submit nominations for the position.



Assistant General Counsel

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